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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/932,588
Filing Date: August 17, 2001
Appellant(s): PANTTAJA ET AL.

Joseph E. Green
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/19/2007 appealing from the Office action mailed 05/03/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 8, 11-13, 15 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda (US 5,937,391).

As per claim 1, Ikeda teaches:

A method in a redemption system for determining which awards to redeem, the method comprising:

maintaining an award history database that includes award transaction information that describes awards earned by a consumer and, for each earned award, the type of award (see figure 8);

maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers (see figure 9). Applicant's specification defines that points is a type of award (see Applicant's specification page 8, lines 7-10) and in Ikeda, points awards earned in shop A cannot be redeemed in shop E (see col 8, lines 1-25; figure 9) and therefore, are encumbered.

receiving a request to redeem an amount of the earned awards at a chosen supplier (see figure 13);

determining allowed awards that can be redeemed with the chosen supplier (see figure 16; see column 11, lines 35-50; “points are redeemed from the oldest one by priority);

determining encumbrance levels of the allowed awards based on the types of allowed awards and the data in the encumbrance database and determining which of the allowed awards, having different encumbrance levels, to redeem based on the encumbrance levels (see figure 16; see column 8, lines 1-25; col 11, lines 50-54). Applicant's specification page 13 teaches “that encumbrance of awards is measured in terms of restrictions on redeeming the awards at certain suppliers”. Ikedu teaches that if a customer “a” requests to redeem 250 points when he or she buys goods at shop B (see col 11, lines 35-55; figure 8), the 200 points earned at shop B with an effective term of 09/04/01, the 100 points earned at shop B with an effective term of 09/04/08 and the 30 points earned at shop B with an effective term of 09/04/09 are not accepted for award redemption at shop E. Ikedu redeems said points by counting said points from the oldest one by priority in order to redeem a total of 250 points at shop B (see col 11, lines 35-55). According to Applicant's specification (see page 11, line 15 – page 12, line 10, figures 3 and 4), when a customer wants to redeem points at supplier 400 (i.e. Ikedu Shop B) with points earned at business 4 (i.e. earned at Ikedu shop B) and business 2 (i.e. earned at Ikedu shop D), said points earned at business 4 (i.e. earned at Ikedu shop B) and said points earned at business 2 (i.e. Ikedu shop D) are not accepted at the same number of supplier (i.e. one), which is supplier 200 (i.e. Ikedu shop E). In Ikedu awards earned at shop E are the most encumbered as said awards have a point value of zero, which are not accepted for redemption in the other stores. Therefore, Ikedu teaches that purchase made at shop B and D are the least encumbered as said purchase are not accepted for award redemption at

only one store (i.e. shop E) and purchase made in shop E are the most encumbered as said purchase are not accepted for award redemption in more than one store (i.e. shop A, B, C).

As per claim 2, Ikeda teaches:

The method of claim 1 wherein determining which of the allowed awards to redeem is further based on expiration dates of the allowed awards (see figure 9 "effective term"; column 6, lines 29-39).

As per claim 3, Ikeda teaches:

The method of claim 1 wherein determining which of the allowed awards to redeem is further based on dates on which the allowed awards were earned (see figure 8, "Purchase data"; see column 8, lines 1-25; "premium points"; see figure 9).

As per claims 4 and 12, Ikeda teaches:

The method of claim 1 wherein the type of award includes from which promotion the award was earned (see figure 8, "points"; see column 8, lines 1-25;; see figure 9; "special period points" shop F).

As per claims 5 and 13, Ikeda teaches:

The method of claim 1 wherein the type of award includes from which business the award was earned (see figure 8, "Name of Shop"; see column 8, lines 1-25; "premium points"; see figure 9; Shop F gives premium points in a special service date).

As per claims 7 and 15, Ikeda teaches:

The method of claim 1 wherein the type of award indicates a classification of the award (see column 8, lines 1-25; "premium points"; see figure 9; column 11, lines 35-50 "points are redeemed by priority from the oldest one).

As per claims 8 and 19, Ikeda teaches:

A method in a redemption system for determining which awards to redeem, the method comprising:

maintaining an award history database that includes award transaction information that describes awards earned by a consumer and including, for each earned award, an expiration date and the type of award (see figure 8);

maintaining an encumbrance database that describes restrictions on redeeming types of awards (see figures 8, 9). Applicant's specification defines that points is a type of award (see Applicant's specification page 8, lines 7-10) and in Ikeda, points awards earned in shop A cannot be redeemed in shop E (see col 8, lines 1-25; figure 9).

receiving a request to redeem an amount of the earned awards (see figure 13);

determining allowed awards that can be redeemed based on the expiration date and the types of awards (see figures 8 and 16; see column 8, lines 1-25; column 11, lines 35-50; points are redeemed by priority and effective term);

determining encumbrance levels of the allowed awards based on the types of the allowed awards and the restrictions on redeeming the allowed awards as maintained in the encumbrance database. The same rejection applied to claim 1 regarding this missing limitation is also applied to claim 8. and

determining which of the allowed awards to redeem based on the earning date (see column 6, lines 40-50; column 11, lines 35-50);

determining which of the allowed awards, having different encumbrance levels, to redeem based on the encumbrance levels (see figure 9). Applicant's specification page 13 teaches "that encumbrance of awards is measured in terms of restrictions on redeeming the awards at certain suppliers". Ikeda teaches that if a customer "a" requests to redeem 250

points when he or she buys goods at shop B (see col 11, lines 35-55; figure 8), the 200 points earned at shop B with an effective term of 09/04/01, the 100 points earned at shop B with an effective term of 09/04/08 and the 30 points earned at shop B with an effective term of 09/04/09 are not accepted for award redemption at shop E. Ikedu redeems said points by counting said points from the oldest one by priority in order to redeem a total of 250 points at shop B (see col 11, lines 35-55). According to Applicant's specification (see page 11, line 15 – page 12, line 10, figures 3 and 4), when a customer wants to redeem points at supplier 400 (i.e. Ikedu Shop B) with points earned at business 4 (i.e. earned at Ikedu shop B) and business 2 (i.e. earned at Ikedu shop D), said points earned at business 4 (i.e. earned at Ikedu shop B) and said points earned at business 2 (i.e. Ikedu shop D) are not accepted at the same number of supplier (i.e. one), which is supplier 200 (i.e. Ikedu shop E). In Ikedu awards earned at shop E are the most encumbered as said awards have a point value of zero, which are not accepted for redemption in the other stores. Therefore, Ikedu teaches that purchase made at shop B and D are the least encumbered as said purchase are not accepted for award redemption at only one store (i.e. shop E) and purchase made in shop E are the most encumbered as said purchase are not accepted for award redemption in more than one store (i.e. shop A, B, C).

As per claim 11, Ikedu teaches:

The method of claim 8 wherein the encumbrance database describes types of awards that cannot be redeemed at one or more suppliers;

wherein receiving a request to redeem further comprises receiving an indication of a chosen supplier at which to redeem the awards; and wherein determining allowed awards is further based on the chosen supplier. The same rejection applied to claim 1 regarding this limitation is also applied to claim 11.

Claim 17 contains the same limitations as claims 2 and 3 therefore the same rejection is applied.

As per claim 18, Ikeda teaches:

The system of claim 17 wherein the first memory and the second memory are a common memory with storage areas for award transaction information and information related to types of awards that cannot be redeemed at one or more suppliers. The same rejection applied to claim 1 regarding this limitation is also applied to claim 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda (US 5,937,391).

As per claims 6 and 14, Ikeda teaches:

The method of claim 1 wherein the type of award indicates black-out dates on which the award cannot be redeemed. However, Official Notice is taken that it is old and well known in the business art that Black-out dates is a well known practice set up by points issuers where certain special dates (i.e. thanksgiving, July 4, etc), are classified black-out dates for the purpose of not allowing customer to redeem said point issuers' products with points when said products would have a guaranteed purchaser that would purchase said products with money instead of points. For example, airlines do not allow their frequent flier

customers to redeem tickets with points in certain dates (i.e. black-out dates) such as July 4, because said airlines know that due to the increase business volume caused by the special date, said airlines would have a guarantee purchaser, which would purchase said tickets with money instead of points, therefore, increasing profits to said airlines. Therefore, airlines would classified certain dates as black-out dates for the purpose of increasing profits and taking advantage of the increase of business volume on those black-out dates. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if shops in the Ikeda's system are able to change redemption ratio at special service dates, the Ikeda system would allow participating shops to indicate special black-out periods, where the point redemption ratio would be zero and points would not be accepted for redemption. For example, a special period such as a Christmas, a shop would change the point redemption ratio to zero (i.e. Black-out period) in order to make customer purchase said shop's products with money instead of points and therefore, take advantage of the increase business volume of said period.

(10) Response to Argument

Appellant's specification teaches that "encumbrance level" is determined based on the types of allowed awards and the data in the encumbrance database" (see Appellant's specification page 2, lines 15-20). Appellant's specification (see figures 3, 4 and page 11, line 10 - page 12, line 10) defines the term "data in the encumbrance database" (see Appellant's specification page 11, line 10 – page 12, line 5), where it explains that if an available award earned by a consumer (i.e. "row 338"; see Appellant's figure 3) is not accepted by one or more suppliers in said encumbrance database (i.e. "suppliers 200, 400" see Appellant's figure 4), said award has a encumbrance level of "encumbered" but if said award is accepted by all suppliers in said encumbrance database (see Appellant's figure 4),

then said award has a encumbrance level of "non-encumbered". For example, the award in row 338 was earned at business 4 and promotion 2 (see Appellant's figure 3) and is not accepted by supplier 400 (See Appellant's figure 4), therefore, said award has an encumbrance level of "encumbered". According to Appellant's specification there are only two encumbrance level with respect to Appellant's encumbrance database (See Appellant's figure 4), said levels are "encumbered" (*i.e.* "not accepted by one or more suppliers") and "non-encumbered" (*i.e.* "accepted by all suppliers"). Nowhere in Appellant's specification is taught or disclosed that if an award is not accepted by three suppliers in said encumbrance database, said award has an encumbrance level of 3 and therefore, is redeemed prior to another award that it is not accepted by two suppliers and have an encumbrance level 2. Therefore, the limitation of "determining which of the allowed awards, having different encumbrance levels to redeem based upon encumbrance levels" simply means, according to Appellant's specification, finding if one or more awards are encumbered because said awards are not accepted by one or more suppliers (See Appellant's specification page 13, lines 10-20) and if multiple awards with the earliest expiration date are found to be encumbered, the Appellant's specification simply teaches that one of said awards may be chosen randomly (see Appellant's specification page 12, lines 5-10).

The Appellant argues in pages 6-7 of the Brief that Ikeda does no teach any form of "determining which of the allowed awards, having different encumbrance levels to redeem based upon encumbrance levels" because according to the Appellant, in Ikeda all the points are equally encumbered and therefore, it is impossible, according to the Appellant, to determine which of the allowed awards having different encumbrance levels to redeem based upon the encumbrance levels. The Appellant further argues in page 10 of the Brief that in Ikeda, if a hypothetical shopper wanted to purchase a product from shop A using

points earned at shop A-D and F-H, a determination of which points to redeem based on encumbrance levels would be impossible because according to the Appellant, all the points are equally encumbered as all of the points are non-redeemable at shop E. Thus, the Appellant argues that Ikeda cannot teach "determining allowed awards having different encumbrance levels, to redeem based on encumbrance levels.

The Examiner answers that if a hypothetical shopper in Ikeda wanted to purchase a product from shop A using points earned at shop A-D and F-H, a determination of which points to redeem based on encumbrance levels would be possible because points earned at shop A-D and F-H would have an encumbrance level of "encumbered" as said points are not accepted by shop E (see Ikeda figure 9) and Ikeda would simply select to redeem from the oldest one by priority (see Ikeda col 11, lines 35-50) one of the awards from shop A-D and F-H and if multiple rows of available awards with the same expiration date and encumbered are identified, Ikeda would simply select randomly one of those encumbered awards, as Appellant's specification discloses that "if multiple rows of available awards with earliest expiration date and the most encumbered are identified, then one of the rows is chosen randomly" (see Appellant's specification page 12, lines 5-10). Furthermore, Ikeda teaches using the type of allowed award in order to determine which awards to redeem, where for example, Ikeda teaches in figure 8 that if a hypothetical customer requests to redeem 250 points when he buys goods at shop B and said customer had earned 200 points at shop B with an expiration date of 01/04/07, 30 points at shop D with an expiration date of 02/04/07 and 100 points at shop B with expiration date of 08/04/07, Ikeda would redeem first, the 200 points earned at shop B with an expiration date of 01/04/07, then would redeem next, the 50 points earned at shop B with an expiration date 08/04/07 and would not redeem the 30 points earned at shop D, even though the expiration date of said points earned at shop D is

older that the expiration date of the points earned at shop B (see Ikeda col 11, lines 10-50). Therefore, Ikeda teaches using the type of allowed awards (i.e. "B points", "D points") to determine which of the allowed awards, having different encumbrance levels (i.e. "B points" showing a different encumbrance level than "D points") in order to determine which points to redeem. Therefore, contrary to Appellant's argument, Ikeda teaches determining allowed awards having different encumbrance levels to redeem based on encumbrance levels, where said encumbrance levels are based upon the type of allowed awards (i.e. "B points" showing a different encumbrance level than "D points") and said encumbrance level is also based upon determining if said awards are "encumbered" (i.e. "points earned at shop B and D are not accepted at shop E") or "not encumbered".

The Appellant presented in page 8 of the Brief, a table that according to the Appellant, teaches that Ikeda cannot determine which of the allowed award to redeem based on encumbrance levels because, according to the Appellant, all awards in Ikeda are encumbered to the same degree, "1". Furthermore, the Appellant presented in page 9 of the Brief a table that according to the Appellant, Ikeda cannot determine which of the award to redeem based upon encumbrance level because according to the Appellant, Ikeda does not teach Appellant's claimed invention of redeeming points beginning with the most encumbered in the following order: 1) awards with an encumbrance level 3, which are awards that are not accepted in three different businesses; 2) awards with encumbrance level 2, which are awards not accepted in 2 different businesses; and 3) awards with encumbrance level 1 which are awards that are not accepted in 1 business.

The Examiner answers that nowhere in Appellant's specification is taught or disclosed that if an award is not accepted by three suppliers, said award has a encumbrance level of 3 and therefore is redeemed first than another award that is not

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accepted by two suppliers and therefore, has a encumbrance level 2. Appellant's specification has support for only two levels of encumbrance, which are "encumbered" which are awards not accepted by one or more suppliers and "not encumbered" that are awards that are accepted by all suppliers (see Appellant's specification page 13, lines 10-20). Therefore, Appellant's table presented in page 9 of the Brief is simply new matter added to the Appellant's specification.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DANIEL LASTRA/

January 29, 2008

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